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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,228	12/06/2001	Atsushi Kikuchi	Q67627	5047

7590 06/26/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/26/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☒ Responsive to communication(s) filed on 12/04/01, 3/4/02, 4/8/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-7 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-12 are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- |  |   |
|--|---|
| <input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ | <input type="checkbox"/> Interview Summary, PTO-413                     |
| <input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892                  | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948           | <input type="checkbox"/> Other _____                                    |

**Office Action Summary**

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a composition, classified in class 525, subclass various.
  - II. Claims 8-12, drawn to a multi-layered product, classified in class 428, subclass various.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a composition for the production of self-supporting films or single-layered products and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. Claims 1-12 are generic to a plurality of disclosed patentably distinct species comprising the various materials embraced by the thermoplastic resin component. The election of an ultimate species defining the thermoplastic resin component is requested. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. During a telephone conversation with Mr. Abraham J. Rosner on June 24, 2003 a provisional election was made without traverse to prosecute the invention of group I comprising polyamide as the ultimate species of thermoplastic resin, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,423,776 (Akkapeddi et al).

Akkapeddi et al disclose oxygen scavenging high barrier polyamide compositions for packaging applications comprising a polyamide e.g., poly(m-xylyleneadipamide), an oxidizable polydiene, e.g., carboxy terminated polybutadiene, and an oxidation promoting metal salt catalyst, most preferably cobalt carboxylate. The oxidizable polydiene is in the form of particles substantially uniformly distributed in the polyamide. Attention is directed to column 6, line 15-23, example 14 and claims.

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added and their contents. It is reasonably believed that the resin composition of the reference, containing essentially the same ingredients as applicants', will inherently meet all the characteristics of the present claims. The onus is shifted to applicants to establish otherwise.

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10. Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,406,766 (Rotter et al).

Rotter et al disclose an oxygen scavenging composition comprising a polycondensate comprising (A) polyester segments and (B) segments from a functionally terminated polydiene. Cobalt octoate is used as the transesterification catalyst (see examples 1 and 2).

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added and their contents. It is reasonably believed that the resin composition of the reference, containing essentially the same ingredients as applicants', will inherently meet all the characteristics of the present claims. The onus is shifted to applicants to establish otherwise.

***Claim Rejections - 35 USC § 103***

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,406,766 (Rotter et al).

Rotter et al disclose an oxygen scavenging composition comprising a polycondensate comprising (A) polyamide segments and (B) segments from a functionally terminated polydiene. The polycondensates are used with additional materials which improve their packaging properties and/or enhance their active oxygen scavenging ability. Specific examples of said enhancing materials include transition metal catalysts such as cobalt carboxylates (column 3, lines 48-51, column 4, lines 7-16). Exemplary functional groups for the polydiene include hydroxyl and carboxyl (column 6, lines 5-31).

In essence the disclosure of the reference differs from the presently claimed invention in not expressly exemplifying a polycondensate comprising a polyamide segment. In this regard, it

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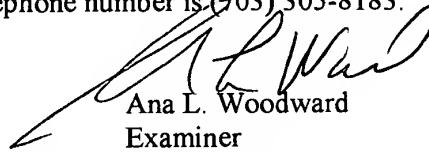
is maintained that it would have been obvious to one having ordinary skill in the art to have employed a polyamide in lieu of the polyester utilized in the examples with the reasonable expectation of success because polyamide is taught as an equivalent to the polyester.

Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (703) 308-2401. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8183.



Ana L. Woodward  
Examiner  
Art Unit 1711

AW  
June 24, 2003